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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,026	02/25/2004	Hans-Jurgen Nolte	PO-8004/LeA 36,450	7133
157	7590	02/08/2006	EXAMINER	
BAYER MATERIAL SCIENCE LLC 100 BAYER ROAD PITTSBURGH, PA 15205			SERGENT, RABON A	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 02/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,026

Applicant(s)

NOLTE ET AL.

Examiner

Rabon Sergeant

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 10-22 and 27-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 23-26 and 60-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/25/04, 8/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1711

1. The foreign priority document, Germany 10308755.9, filed 02/28/2003, has not been received.
2. Applicant's election without traverse of Group I, claims 1-9, 23-26, and 60-67 in the reply filed on October 28, 2005 is acknowledged.
3. Claims 1-9, 23-26, and 60-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claim 1, it is unclear what is meant or intended by the language, "repeatedly in succession"; furthermore, it is unclear how "in succession" is to further modify "repeatedly".

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 1711

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-4, 6, 7, 23-25, and 60-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Kahl et al. ('518).

Patentees disclose the homogenation of two component aqueous polyurethane coating compositions by forcing the aqueous two component mixture through a jet disperser. Patentees further disclose an embodiment wherein the stream recycles back to be introduced into the jet disperser (homogenizer) again. See Figure 5. The position is taken that this disclosure meets applicants' claims. With respect to claims 63, 66, and 67, the position is taken that applicants have not established that the process limitations of claims 5, 8, and 9, respectively, yield a patentably distinct product.

6. Claims 1-9, 23-26, and 60-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahl et al. ('518) in view of Bock et al. ('419) or Burke, Jr. ('698 or '700 or '701) or Khungar et al. ('142) or Dong et al. (US 2001/0012872).

As aforementioned, Kahl et al. disclose the homogenation of two component aqueous polyurethane coating compositions by forcing the aqueous two component mixture through a jet disperser. Patentees further disclose an embodiment wherein the stream recycles back to be introduced into the jet disperser (homogenizer) again. See Figure 5. In addition to this teaching, the position is taken that the use of recycle streams to reintroduce dispersions and emulsions into homogenizers to improve their properties has long been known in the art. The Burke, Jr. references disclose at column 24, the use of homogenizers in combination with recycle to improve such emulsion properties as particle size and particle size distribution. Khungar et al.

Art Unit: 1711


disclose at column 5, lines 39+ that recirculation through a homogenizer is useful to obtain optimum homogenization of monomer mixes. Dong et al. disclose within paragraph [0015] the use of a recycle loop in combination with homogenization to ensure emulsion stability.

Furthermore, both Kahl et al. (column 6, lines 49-52) and Bock et al. (column 5, line 66 through column 6, line 8) disclose the use of homogenizers in series, which is considered to be analogous to using a recycle stream. Therefore, given these additional teachings, the position is taken that it would have been obvious to practice the method of Kahl et al. using a recycle stream to reintroduce the composition into the homogenizer, so as to obtain improved dispersions.

Furthermore, though the references fail to disclose applicants' claimed flow rates and gear pumps, the position is taken that the selection of such conditions and equipment amounts to the obvious selection and optimization of conventional chemical engineering practices and equipment.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
February 5, 2006


RABON SERGENT
PRIMARY EXAMINER